

**REMARKS**

Claims 1-24 were originally filed in the present application.

Claims 1-24 are pending in the present application.

Claims 1-24 were rejected in the September 10, 2007 Office Action.

Claims 1-24 were objected to in the September 10, 2007 Office Action.

No claims have been allowed.

Claims 1, 8, 9, 12 and 20 are amended herein.

Claims 1-24 remain in the present application.

Reconsideration of the claims is respectfully requested.

Applicant notes that amendments to the claims included herein do not add any new matter.

Accordingly, Applicant respectfully requests that these amendments be entered.

**I. CLAIM OBJECTIONS**

The Examiner objected to Claims 1-24 because Claims 1, 9, 12 and 20 recite the limitation “allocate an allocated [voice path].” These claims have been amended to remove the phrase “an allocated” and “at least one allocated.” Therefore, Applicant respectfully requests that the objections to the claims be withdrawn.

The Examiner also objected to Claim 9 under 37 C.F.R. 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claim 9 has been

amended to include additional elements that are not included in Claim 1. Therefore, Applicant respectfully requests that the objection to Claim 9 be withdrawn.

## **II. REJECTION UNDER 35 U.S.C. § 112**

The Examiner rejected to Claims 1 and 20 under 35 U.S.C. §112, second paragraph, as being indefinite. Claim 1 has been amended to change “telecommunication system” to “apparatus.” Thus, antecedent basis exists for the phrase, as amended. Therefore, Applicant respectfully requests that the rejection to Claim 1 be withdrawn.

The Examiner questioned whether Claim 20 was an apparatus claim or a method claim because of the mention of a “telecommunication device” in the preamble. Claim 20 provides a method claim that is a method of testing the voice paths in a telecommunication device. The preamble describes the telecommunication device as having switching fabric that includes a plurality of voice paths; however, the description of the telecommunication device in the preamble does not change the status of the claim as a method claim. The preamble clearly states that what is claimed is “a method of testing the voice paths in said telecommunication device, the method comprising the steps of:...” Therefore, Applicant respectfully requests that the rejection to Claim 20 be withdrawn.

## **III. REJECTION UNDER 35 U.S.C. § 103**

The Examiner rejected under 35 U.S.C. §103(a) Claims 1-18 and 20-24 as being unpatentable over *SIP-based VoIP Network and its Interworking with the PSTN* by Zhang (“Zhang”). The

Examiner also rejected under 35 U.S.C. §103(a) Claim 19 as being unpatentable over *Zhang* in view of U.S. Patent Application Publication No. 2002/0114317 to Dorenbosch ("*Dorenbosch*"). Of these, Claims 1, 9 and 20 are independent. These rejections are respectfully traversed for the reasons discussed below.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992).) The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984).) Only when a *prima facie* case of obviousness is established does the burden shift to the Applicant to produce evidence of non-obviousness. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993).) If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the Applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).)

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference

(or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must not be based on the Applicant's disclosure. (*MPEP* § 2142).

In order to establish obviousness by combining references there must be some teaching or suggestion in the prior art to combine the references. (*Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 U.S.P.Q.2d 1294, 1297 (Fed. Cir. 1997) ("It is insufficient to establish obviousness that the separate elements of an invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the references."); *In re Rouffet*, 149 F.3d 1350, 1355-56, 47 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1998) ("When a rejection depends on a combination of prior art references, there must be some teaching, or motivation to combine the references.").)

Evidence of a motivation to combine prior art references must be clear and particular if the trap of "hindsight" is to be avoided. (*In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999) (Evidence of a suggestion, teaching or motivation to combine prior art references must be "clear and particular." "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'"); *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998) ("[R]ejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'"))

The Applicant respectfully submits that *Zhang* fails to disclose, teach or suggest “a test controller configured to receive a test call from an originating terminal, to prompt the telecommunication device to allocate one of the voice paths within the telecommunication device for the test call and to establish a call connection for the test call between the originating terminal and a destination terminal via the allocated voice path and a packet-switched network to test the allocated voice path,” as recited by independent Claim 1, as amended.

To show the claimed test controller and originating terminal, the Examiner cited *Zhang*’s SIP server and SIP client, respectively, as shown in Figure 8. Office Action, page 4. However, the Examiner has failed to cite, and Applicant is unable to find, any reference within *Zhang* to the SIP server receiving a test call from the SIP client. In addition, the Examiner also cites the establishment of a SIP call between Dan and Shirley described in *Zhang* to show the establishment of a call connection for the test call between the originating terminal and a destination terminal. Office Action, page 4. However, the description of the SIP call establishment in *Zhang* relates to the establishment of a standard SIP call not to the establishment of a test call to test a voice path. See *Zhang*, pages 277-279. *Zhang* simply describes the use of SIP as an alternative to the H.323 standard for signaling in voice-over IP communication. Thus, *Zhang* describes the SIP protocol stack, the main features of SIP, and the architecture, messaging and operation of SIP. *Zhang*, Abstract. There is no mention in *Zhang* of a system for testing a voice path of a telecommunication device.

Furthermore, the Examiner admits that *Zhang* fails to disclose the allocation of a voice path within the telecommunication device for the test call and the establishment of a call connection for

the test call via the allocated voice path and a packet-switched network to test the allocated voice path. Office Action, page 5. The Examiner then claims that it would have been obvious “to allocate a voice path and connect to the packet-switched network to terminate to the destination terminal by configuring routing translations so that calls destined for the IP phone will be routed to the PSTN or looped back at the media gateway prior to being delivered through the packet-switched network.” Office Action, page 5 (emphasis added).

However, the claimed invention does not provide for routing the test call such that the test call is not delivered through the packet-switched network. Instead, a call connection for the test call is established between the originating terminal and a destination terminal via the allocated voice path and a packet-switched network to test the allocated voice path. Thus, the call connection is established via the packet-switched network, not by being routed to the PSTN or looped back prior to being delivered through the packet-switched network. Therefore, for at least these reasons, a *prima facie* case of obviousness against independent Claim 1, as amended, has not been presented with reference to the cited art, either alone or in combination. Therefore, the Applicant respectfully submits that this rejection should now be withdrawn.

Similar to independent Claim 1, independent Claim 9 recites a telecommunication system comprising “an originating terminal placing a test call; and a test controller configured to receive the test call from the originating terminal, to prompt the telecommunication device to allocate one of the voice paths within the telecommunication device for the test call and to establish a call connection for the test call between the originating terminal and a destination terminal via the allocated voice

path and a packet-switched network to test the allocated voice path,” and independent Claim 20 recites “receiving a signaling message for a test call from an originating terminal; sending a signaling message to the telecommunication device to allocate one of the voice paths for the test call in the telecommunication device; establishing a connection between the originating terminal and a destination terminal for the test call through a packet-switched network using the allocated voice path; and testing the allocated voice path during the test call.” Accordingly, for the reasons discussed above in connection with Claim 1, independent Claims 9 and 20 are not made obvious by the cited art. Therefore, the Applicant respectfully submits that these rejections should now be withdrawn.

Dependent Claims 2-8, which depend from independent Claim 1, dependent Claims 10-19, which depend from independent Claim 9, and dependent Claims 21-24, which depend from independent Claim 20, are also not made obvious by the cited art because they include the limitations of their respective base claims and add additional elements that further distinguish the art. Therefore, the Applicant respectfully submits that these rejections should now be withdrawn.

The Applicant also disagrees with the Examiner’s rejections of Claims 1-24 based on additional misdescriptions and/or misapplications of *Zhang* and *Dorenbosch* to at least some of Claims 1-24. However, the Applicant’s arguments regarding those other shortcomings of *Zhang* and *Dorenbosch* are moot in view of the Claim 1 arguments above. However, the Applicant reserves the right to dispute in future Office Action responses the appropriateness and the applications of *Zhang*

and *Dorenbosch* to the claims of the present application, including the right to dispute assertions made by the Examiner in the September 10, 2007 Office Action.



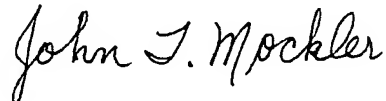
**SUMMARY**

For the reasons given above, the Applicant respectfully requests reconsideration and allowance of the pending claims and that this application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *[jmockler@munckbutrus.com](mailto:jmockler@munckbutrus.com)*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK BUTRUS CARTER, P.C.



John T. Mockler  
Registration No. 39,775

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P.O. Drawer 800889  
Dallas, Texas 75380  
Phone: (972) 628-3600  
Fax: (972) 628-3616  
E-mail: *[jmockler@munckbutrus.com](mailto:jmockler@munckbutrus.com)*